

Applicant: Gardi et al.
Filed: June 29, 2001
Application No.: 09/893,597

REMARKS

The present Amendment Response is responsive to the final Office Action mailed August 22, 2006. As a preliminary matter, Applicants have amended Claims 1, 6, 8-9, 12-13, and 18-24; cancelled Claims 5, 17, and 25; and added new Claims 26-38. Claims 1-4, 6-16, 17-24, and 26-38 remain pending. Applicants respectfully submit that support for these amendments and additions can be found in the specification and that no new subject matter has been added by the afore-mentioned claim amendments or additions.

Additionally, Applicants respectfully submit that in Section 4 of the final Office Action the Examiner rejected independent Claim 20 under 35 U.S.C. § 103(a) but directed the detailed rejection to independent Claim 25. Applicants are assuming the Examiner intended to only reject Claim 25 under Section 4.

Accordingly, Applicants respectfully request reconsideration and allowance of the application.

Claim Rejections under 35 U.S.C. § 112, first paragraph

In the final Office Action, Claims 1-28 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. More specifically, the Examiner states that the specification does not provide support for the limitation requiring that wherein the qualification information does not include financial factors associate with the received billing information, historical billing information associated with the customer

Applicants respectfully submit that the specification provides more than adequate support for Claims 1-28 as amended. The Examiner bases the rejection on the first sentence of paragraph [0035]. The Applicants, however, assert that the Examiner construed this statement out of context of the entire paragraph [0035]. Reading the entire paragraph [0035] further explains that the present invention can provide “automated techniques for billers and others to target customers *based upon any information* they maintain or have access to about customers,” (emphasis added), for example “customer relationship management system.” Thus, reading the entire paragraph [0035] provides support that the present invention does not have to use financial

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factors, rather *any information* the users have may be used to determine if the customer qualifies for presentment. Similarly, paragraph [0015] states that “billing information … is not used to determine if the customer qualifies for presentment of this supplemental information item” and that “a customer’s credit history, credit rating, or credit availability is not used to determine if the customer qualifies” Furthermore, Applicants assert that it is the Examiner’s duty to interpret the entire specification in light of how one having ordinary skill in the art would interpret, *see In re Alton*, 76 F.3d 1168, 1175, 37 USPQ2d 1578 (Fed. Cir. 1996) (“If a person of ordinary skill in the art would have understood the inventor to have been in possession of the claimed invention at the time of filing, even if every nuance of the claims is not explicitly described in the specification, then the adequate written description requirement is met.”), and that when doing so, clear support for Claims 1-28 is present in the specification. Accordingly, Applicants respectfully assert that the rejection of Claims 1-28 under 35 U.S.C. § 112, first paragraph, is improper and that Claims 1-28 have adequate support as required. Furthermore, Applicants also submit that all amendments and new claims presented in the present response have sufficient support under 35 U.S.C. § 112, first paragraph.

Claim Rejections under 35 U.S.C. § 103(a) under Walker and Katz

In the final Office Action, independent Claims 1, 13, and 25 and dependent Claims 2-7 and 14-19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,196,458 to Walker et al. (“Walker”) in view of U.S. Patent No. 6,055,513 to Katz et al. (“Katz”).

As an initial matter, Applicants reiterate their assertion set forth in the Amendment dated June 19, 2006 that there is no motivation, teaching, or suggestion to combine Katz with Walker. Notwithstanding, assuming *arguendo*, that combination of Katz with Walker is proper, Applicants respectfully submit that amended Claims 1 and 13 are patentable over said combination. Applicants have cancelled Claim 25, rendering the Examiner’s rejection thereof moot.

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In response to the rejection, Applicants have amended Claim 1 to include the added element of “wherein determining if the customer qualifies for presentment of the supplemental information item includes transmitting a request to a customer relationship management system to determine if the customer qualifies for presentment of the supplemental information item and receiving a response from the customer relationship management system indicating one of 1) that the customer qualifies for presentment of the supplemental information item, or 2) that the customer does not qualify for presentment of the supplemental information item.” Applicants assert that Walker in combination with Katz does not teach “transmitting a request to a customer relationship management system” and “receiving a response from the customer relationship management system.” Specifically, Applicants assert that the Examiner’s interpretation of Walker is improper, and that if the central controller of Walker is a “CRM” system, then Walker discloses no system element to transmit a request to and receive a response from the central controller. Likewise, if the central controller is the element transmitting and receiving the requests, then Walker discloses no CRM system for receiving requests and transmitting requests. Furthermore, Applicants assert that Katz does not disclose a “CRM” system as claimed in the amended Claim 1. Accordingly, Applicants respectfully assert that Claim 1 as amended is patentable over Walker, Katz, and the combination of Walker and Katz under 35 U.S.C. § 103(a), and is in condition for allowance. Furthermore, Claims 2, 3-4, and 6 are allowable as a matter of law as depending from an allowable claim, notwithstanding their independent recitation of patentable features.

In response to the rejection, Applicants have similarly amended independent Claim 13 to recite “wherein determining if the customer qualifies for presentment of the supplemental information item includes transmitting a request to a customer relationship management system to determine if the customer qualifies for presentment of the supplemental information item and receiving a response from the customer relationship management system indicating one of 1) that the customer qualifies for presentment of the supplemental information item, or 2) that the customer does not qualify for presentment of the supplemental information item.” For at least the same reasons as provided for amended Claim 1, Applicants respectfully assert that Claim 13

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as amended is patentable over Walker, Katz, and the combination of Walker and Katz under 35 U.S.C. § 103(a), and is in condition for allowance. Furthermore, Claims 14-16 and 18-19 are allowable as a matter of law as depending from an allowable claim, notwithstanding their independent recitation of patentable features.

Applicants have cancelled Claims 5, 17, and 25, rendering the Examiner's rejections thereof moot.

Additionally, in the final Office Action, independent Claims 8 and 20 and dependent Claims 9-12 and 21-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Katz in view of U.S. Patent No. 5,761,650 to Munsil et al. ("Munsil").

As an initial matter, Applicants assert that there is no motivation, teaching, or suggestion to combine Katz with Munsil. Notwithstanding, assuming *arguendo*, that combination of Katz with Munsil is proper, Applicants respectfully submit presently amended Claims 8 and 20 are patentable over said combination because the combination fails to disclose every element of Claims 8 and 20.

In response to the rejection, Applicants have amended Claim 8 to recite "determining if the first and second supplemental information items can be presented together" and "wherein, if the customer is determined to qualify for presentment of the first and the second supplemental information items and if the first and second supplemental information items are determined not to be presentable together, the generated bill presentation includes the received billing information and the one of the first and the second supplemental information items having a highest priority." Applicants assert that neither Katz nor Munsil, nor a combination thereof, teach "determining if the first and second supplemental information items can be presented together." In the Office Action, when rejecting Claims 8-12 the Examiner combines Munsil with Katz to provide the feature of prioritizing the supplemental information. However, Munsil, and similarly Katz, do not recite making a first determination if the supplemental information can be presented together. Therefore, Applicants submit that neither Munsil, Katz, nor the combination of Munsil and Katz, recite all limitations of Claim 8 as amended. Accordingly, Applicants respectfully assert that Claim 8 is patentable over Munsil, Katz, and the combination of Munsil

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and Katz, and is in condition for allowance. Furthermore, Claims 9-12 are allowable as a matter of law as depending from an allowable claim, notwithstanding their independent recitation of patentable features.

In response to the rejection, Applicants have similarly amended independent Claim 20 to recite “determine if the first and second supplemental information items can be presented together” and “wherein, if the customer is determined to qualify for presentment of the first and the second supplemental information items and if the first and second supplemental information items are determined not to be presentable together, the generated bill presentation includes the received billing information and the one of the first and the second supplemental information items having a highest priority.” For at least the same reasons as provided for amended Claim 8 above, Applicants respectfully assert that Claim 20 is patentable over Munsil, Katz, and the combination of Munsil and Katz, and is in condition for allowance. Furthermore, Claims 21-24 are allowable as a matter of law as depending from an allowable claim, notwithstanding their independent recitation of patentable features.

Allowability of New Claims Added under this Amendment

Applicants have added a new independent Claim 26, which includes, among others, the limitations of “modifying the qualification information based on the first customer response” and “determining if the second customer qualifies for presentment of a second supplemental information item based upon the qualification information.” Applicants assert that the prior art as cited herein and by the Examiner does not teach these features. Although the Examiner, in his rejection of dependent Claims 7 and 19 in the final Office Action, cited Katz, column 11 lines 40-45, for the modification and presentment features, Applicants urge that Katz does not teach modifying qualification information from a first customer and applying the modification rules to a second customer. Accordingly, Applicant respectfully submit that Claim 26 is allowable, in light of prior art references cited, and in condition for allowance. Furthermore, Claims 27-31 are allowable as a matter of law as depending from an allowable claim, notwithstanding their independent recitation of patentable features.

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Applicants have added a new independent Claim 32, which includes limitations similar to the above-discussed Claim 26, such as "modify the qualification information based on the first customer response" and "determine if the second customer qualifies for presentation of a second supplemental information item based upon the qualification information." For at least the same reasons as provided for Claim 26 above, Applicants respectfully submit that Claim 32 is allowable, in light of prior art references cited, and in condition for allowance. Furthermore, Claims 34-38 are allowable as a matter of law as depending from an allowable claim, notwithstanding their independent recitation of patentable features.

CONCLUSION

It is not believed that extensions of time or fees for addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 19-5029.

Respectfully submitted,



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